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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,856	02/23/2004	Mark Roland Boeder	CHRE:180	5475
7590 09/11/2007				
Charles A Wendel Steptoe & Johnson LLP. 1330 Connecticut Avenue N.W. Washington, DC 20036				
			EXAMINER HELMER, GEORGIA L	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,856

Applicant(s)

BOEDER, MARK ROLAND

Examiner

Georgia Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Final Office Action

1. Applicant's 18 June 2007 response to the NonFinal Office Action of 18 December 2006 is acknowledged.
2. This action is made Final.

Claim Rejections - 35 USC § 102

3. Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by the Assignee's printed 2003 catalogue publication first distributed in November 2002 in light of the fact that the plant was sold in the Dutch auctions of 2002. See (16 June 2005 Response, p. 2, 1st full ¶).

Applicant traverses saying primarily "[I]n the present application, there is no evidence in this record that sale in the Netherlands any time more than one year before the filing date of the present application, in fact result in, or could have resulted in, possession in the United States of plant material "to practice asexual reproduction of the plant" as claimed herein in a manner consistent with the statue". See (Response of 6/18/2007, p. 4, 2nd ¶.) Applicant cites *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004).

Applicants traversal is unpersuasive. The pending rejection is a 102(b) anticipation rejection over a printed publication.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1638

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This rejection was originally set forth in the Office Action mailed 3 November 2004, and again in the Office Action mailed 18 December 2006. This 102(b) rejection requires two elements as it relates to the instant fact pattern:

These elements are that ***the invention was ... described in a printed publication (a) in this or a foreign country ..., more than one year prior to the date of application for patent in the United States (b).***

(a) The instant invention was described in a "printed publication" in the Netherlands as of November 2002. ¹

(b) The instant application was filed in the US 23 February 2004. This time period is more than one year after the November 2002 publication.

The new plant was sold in the Netherlands in 2002. ² This provides extrinsic evidence that the November 2002 publication was enabled. This does "place the public in possession of the claimed invention before the critical date". See *Elsner*. Possession in the United States is irrelevant because this is not the portion of the statute the rejection on which the rejection is based. It is noted that the Applicant's stipulations that the plant was sold/available through the Dutch

¹ Assignee's printed 2003 catalogue distributed first in November 2002 is a "printed publication" under U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *Wyer*, op. cit. and MPEP 2128

Art Unit: 1638

Auctions obviate any further need to address accessibility. Elsner was used to establish asexual reproducibility of the claimed plant, which in the present case was established by reference to the Royal Horticultural Society article.

Remarks

4. No claim is allowed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on 10-6 Monday & Tuesday, 1-5 pm Thursday.

² See Applicant's Reply to Requirement for Information under 1.105 dated 6/16/2005, 1st full ¶.

Art Unit: 1638

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Georgia Helmer PhD
Patent Examiner
Art Units 1638/1661
27 August 2007

/Wendy C. Haas/

Primary Examiner AU 1661